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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,533	08/08/2001	Daisuke Nohara	Q65728	2113

7590 12/16/2003
SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,533	Applicant(s) NOHARA ET AL.	
	Examiner Katarzyna Wyrozebski Lee	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-21 is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

In view of an updated search and structure search conducted on 11/25/2003 following second non-final office action is necessitated.

Claims Analysis

It should be noted that the claims oriented towards an additive are compound claims, since limitation "for rubber composition" is an intended use.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

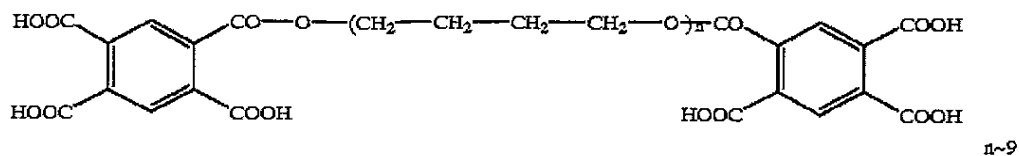
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 10 are rejected under 35 U.S.C. 102(a) as being anticipated by BELL (US 6,207,283).

The prior art of BELL (published approx. 5 months before filing date of the present invention discloses following compound (col. 3 and 4).

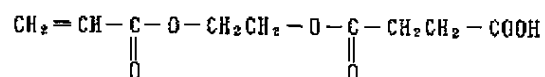


Since the applicants have not specified what is the R constituent of an acyl group, this prior art anticipates requirements of claims rejected above.

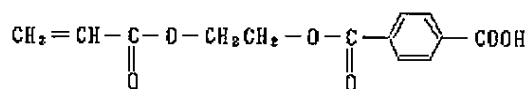
3. Claims 1, 2, 5, 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by ADACHI (JP 06-118648).

The prior art of ADACHI discloses following compounds on page 6 of the translation:

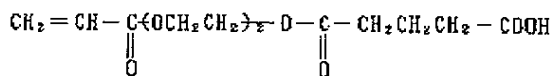
1



2

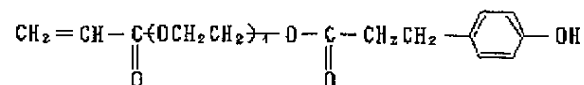


3

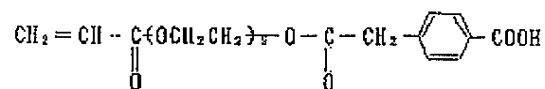


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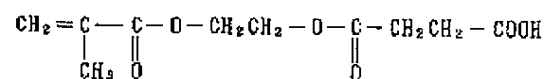


5

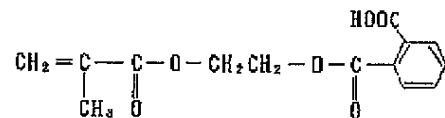


Page 7 of the translation further teaches following:

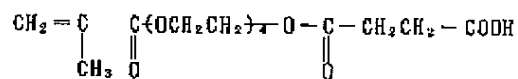
6



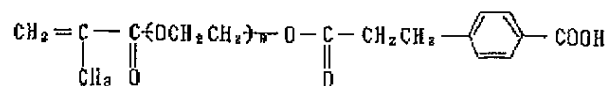
7



8



9



Since the present invention does not disclose that the R constituent on the acyl group, the compounds of ADACHI anticipate claims rejected above.

Claim Objections

4. Claims 1 and 5 are objected to because of the following informalities: contain inappropriate parentheses. Appropriate correction is required.

Allowable Subject Matter

5. Claims 3, 4, 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art applied against present claims teaches compounds that only have acyl group in place of R2 or R4, whereas claims 3, 4, 6-8 require alkyl or alkenyl.

6. Claims 12-21 are allowed.

The prior art of record teaches use of the compound in photosensitive composition, which is entirely different from use in claims 12-21. Claims 12-13 require that the additive be a mixture of the above compound with carbon black and the prior art of record does not teach this. Claims 14-21 require that the additive be utilized in rubber composition, and prior art of record does not teach rubber composition, in fact it is an entirely different field of endeavor.

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Other documents found during the structure search that does teach the use of a compound in rubber composition include JP 2003268098 to KUBOTA published in 2003; JP 2003119319 to NOHARA published in 2003; JP 2003119318 to NOHARA published in 2003. Due to its publication date these documents do not qualify as a prior art.

Beginning December 12, 2003 the new phone number for the examiner of record will be 571-272-1127.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Katarzyna Wyrozebski Lee
Primary Examiner
Art Unit 1714

December 5, 2003